

Applicant wishes to disqualify Maehara as prior art against the presently claimed invention under 35 U.S.C. 102(e)/103 . Applicant's undersigned attorney states for the record that the subject application and Maehara, were, at the time the invention of the present application was made, owned by Canon Kabushiki Kaisha.

The present application is assigned to Canon Kabushiki Kaisha, as evidenced by the Notice of Recordation of Assignment document dated October 2, 2001 at Reel 012020, Frame 0549 of record herein. Maehara was assigned to Canon Kabushiki Kaisha by the Assignment recorded on September 21, 2000 at Reel 11100, Frame 0750, a copy of which is attached for the Examiner's convenience.

Accordingly, since Maehara has been disqualified as a reference under U.S.C. 102(e)/103, the above obviousness rejection based on this document should be withdrawn.

Applicant respectfully submits that new claims 24 and 25 should be examined and allowed in the subject application without a restriction requirement.<sup>1</sup>

Claim 24 is directed to a combination that includes a subcombination of any one of claims 17-23. The Examiner will note that although, hypothetically, there may be another subcombination or feature that could make the optical apparatus of claim 24 patentable independent of the recited subcombination, the propriety of a requirement for restriction must be determined only on the basis of the features that are recited in the claim presented for examination and not on the basis of a hypothetical scenario. Since the

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<sup>1</sup>/The Examiner will note that such a restriction requirement was timely traversed by Applicant.

subcombination of any one of claims 17-23 is the only recited feature in the combination of claim 24, this subcombination must be an "essential distinguishing feature" within the meaning of M.P.E.P. § 806.05(c)(II) for claim 24 to be patentable in its present form. Thus, clearly, a requirement for restriction would not be proper. Furthermore, since claims 17-23 are patentable for the reasons discussed above, claim 24 must also be patentable.

Claim 25 is directed to a method of using the apparatus of claim 24.

Therefore, under M.P.E.P. § 821.04, claim 25 should be examined in the subject application.

Wherefore, Applicant respectfully requests that the present claims be allowed and the case be passed to issue.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

  
Attorney for Applicant

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## APPENDIX

Application No. 09/910,928  
Attorney Docket No. 03500.015601

### IN THE CLAIMS:

Claims 1-5 and 10-16 have been cancelled.

Claims 17-23 have been amended as follows:

17. (Amended) An optical element having a film on its surface, said film comprising at least one layer of silica containing fluorine [The optical element according to claim 16], wherein a concentration of the fluorine in the layer or layers of silica is not less than 0.1 mol% nor more than 10 mol%.

18. (Amended ) An optical element having a film on its surface, said film comprising at least one layer of silica containing fluorine [The optical element according to claim 16], wherein said concentration of the fluorine is not less than 1 mol%.

19. (Amended) An optical element having a film on its surface, said film comprising at least one layer of silica containing fluorine [The optical element according to claim 16], wherein a refractive index of the layer or layers of silica for F<sub>2</sub> laser light is 1.60 to 1.80.

20. (Amended) An optical element having a film on its surface, said film comprising at least one layer of silica containing fluorine [The optical element according to

claim 16], wherein said film further comprises a layer of a material selected from the group consisting of  $\text{MgF}_2$ ,  $\text{LiF}$ , and  $\text{Na}_3\text{AlF}_6$ .

21. (Amended) The optical element according to claim 17 [16], wherein said element is comprised of fluorite.

22. (Amended) The optical element according to claim 17 [16], wherein said element is comprised of silica containing fluorine.

23. (Amended) The optical element according to claim 17 [16], wherein said film is an antireflection coating.

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# Assignment

FOR VALUE RECEIVED

Hiroshi MAEHARA

citizen(s) of Japan

residing at (respectively)

4-36-2-201 Konandai, Konan-ku, Yokohama-shi, Kanagawa-ken, Japan

hereby sell, assign, transfer and convey unto

CANON KABUSHIKI KAISHA, a corporation of Japan having a place of business at  
3-30-2 Shimomaruko, Ohta-ku, Tokyo, Japan,

its successors, assigns and legal representatives (hereinafter called the "Assignee"), the entire right, title and interest, for the United States in and to certain inventions relating to

OPTICAL ELEMENT

and described in an application for Letters Patent of the United States filed on 5/APR/2000 as Application No. 09/542,340 and in and to said application, and all divisions, renewals and continuations thereof, and all Letters Patent of the United States which may be granted thereon, and all reissues and extensions thereof; and I hereby authorize and request the Commissioner for Patents and Trademarks of the United States to issue all Letters Patent upon said inventions to the Assignee or to such nominee as it may designate.

AND I authorize and empower the said Assignee or nominee to invoke and claim for any application for patent or other form of protection for said inventions, the benefit of the right of priority provided by the International Convention for the Protection of Industrial Property, as amended, or by any convention which may henceforth be substituted for it, and to invoke and claim such right of priority without further written or oral authorization from me.

AND I hereby consent that a copy of this assignment shall be deemed a full legal and formal equivalent of any assignment, consent to file or like document which may be required in the United States for any purpose and more particularly in proof of the right of said Assignee or nominee to claim the aforesaid benefit of the right of priority provided by the International Convention for the Protection of Industrial Property, as amended, or by any convention which may henceforth be substituted for it.

AND I hereby covenant that I have the full right to convey the entire right, title and interest herein assigned and that I have not executed and will not execute any agreement in conflict herewith.

AND I hereby covenant and agree that I will communicate to said Assignee or nominee all facts known to me pertaining to said inventions, and testify in all legal proceedings, sign all lawful papers, execute all divisional, continuing and reissue applications, make all rightful oaths and declarations and in general perform all lawful acts necessary or proper to aid said Assignee or nominee in obtaining, maintaining and enforcing all lawful patent protection for said inventions in the United States.

By: Hiroshi Maehara  
HIROSHI MAEHARA

Date: August 21, 2000

By: \_\_\_\_\_

Date: \_\_\_\_\_

By: \_\_\_\_\_

Date: \_\_\_\_\_